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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,910	07/30/2003	Roy Lillqvist	60091.00217	6100

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EXAMINER

ADAMS, CHARLES D

ART UNIT	PAPER NUMBER
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2164

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/629,910

Applicant(s)

LILLQVIST ET AL.

Examiner

Charles D. Adams

Art Unit

2164

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-12.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____


CHARLES RONES
SUPERVISORY PATENT EXAMINER

Continuation of 3. NOTE: The amendments to the independent claims 1, 9, and 11-12 and the newly added claims 13-15 raise new issues that would require further consideration and/or search. .

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues that Kim et al. does not teach an "Internet domain name comprising a plurality of successive labels separated by dots". Applicant is directed towards the Final Rejection of 26 July 2006, section 7. Applicant further argues that dots and dashes are not functionally equivalent as delimiters to separate one label from another in the field of the Internet. However, Examiner asserts that dots and dashes are functionally equivalent as delimiters when writing strings and converting strings from one format to another. Applicant argues several experiments to show that "dots and dashes are not functionally equivalent".

However, the claims are limited to a method of "receiving data" for a database, wherein the "data includes at least one Internet domain name" (see section 7 of the Final Rejection of 26 July 2006 for arguments as to why Kim et al. shows an "Internet Domain Name") "comprising a plurality of successive labels separated by dots". The claims read as a method of converting strings of one format to another format. The method of the present application contains labels separated by dots. Kim et al. contains labels separated by dashes. As they are both strings existing in one format being converted to another format, the delimiters (dots and dashes) are functionally equivalent because they both serve to separate the labels. The choice of dots or dashes is read as a design choice, because the delimiters' sole claimed function is to separate labels from each other.

Applicant's argues that the "conditionally converting" step is definite. This argument is incorrect. MPEP § 2106 Section II(C) states that "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (Page 17). In this case, the steps following the "conditional" may not actually occur, because they are based on a condition. If that condition remains unfulfilled, the steps are not taken.

Applicant argues that the Office Action incorrectly considers "wherein the predetermined number of labels is three" to be a size. This argument is incorrect. The Office Action maintains the 'number of labels' is a size, for the question "how many" can be answered with a "size", wherein size is the number of items. Though the case law isn't directed towards the computer medium, the principle still applies. Claim limitations that are different from the prior art in items only in size are obvious. Paragraph [0033] of Kim et al. gives an example name address as "#042-123-4567". This address contains three labels, while the previously listed address contains four. This provides further evidence that it would have been obvious to one of ordinary skill in the art to simply change the number of labels

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, proper motivation to combine the references can be found in Khello, paragraph [0054], as listed in the Office Action of 26 July, 2006, section 10.

In response to applicant's argument that the references are directed towards a different problem than the present application, Examiner notes that even though the references and the present application may be directed towards solving different problems, the prior art still teaches the subject matter claimed in the present application. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are in applicant's field of endeavor.